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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/764,139	01/19/2001	Hisashi Yamagishi	Q61127	9352

7590 03/23/2004  
SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC  
2100 PENNSYLVANIA AVENUE, N.W.  
WASHINGTON, DC 20037-3213

EXAMINER

HUNTER, ALVIN A

ART UNIT	PAPER NUMBER
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3711

13

DATE MAILED: 03/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/764,139

Applicant(s)

YAMAGISHI ET AL.

Examiner

Alvin A. Hunter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 09/129,883.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Priority***

This application is not currently entitled to the benefit of the filing date of any prior application because no appropriate statement of priority has been presented. The only domestic priority currently being claimed is to Provisional Application No. 60/058563 (which was filed in Japanese). However, this application and the provisional application are not copending since the provisional application expired on September 11, 1998. Similarly, the application is not currently entitled to the benefit of the filing date of the Japanese application listed in the oath/declaration because this application was not filed within one year of the filing date of the Japanese application. In the event that the priority claim is perfected, neither application can be used to antedate an intervening reference unless a certified translation of each is provided.

In addition, it appears that the reference to the provisional application in the specification cites a statute incorrectly since there does not appear to be a section §10 119(e)(i) in Title 35. The correct citation appears to be 35 U.S.C. 119(e)(i).

### ***Oath/Declaration***

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

Oath identifies prior U.S. Provisional Application No. 60/058563 as a foreign application. A new oath or declaration is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recited a core deformation range broader than that of claim 4, therefore, claim 2 is rejection. A dependent claim cannot be broader than the claim from which it depends upon.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 2-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamagishi et al. (USPN 5695413) in view of Kasashima et al. (JP Publication 09-290034).

Yamagishi et al. (USPN 5695413) discloses a multi-layered golf ball having a two-layered core and cover (See Figure 1). The inner core has a distortion of 3.5mm under an applied load of 100kg (See Figure 1). The cover layer has a Shore D hardness of 50 to 60 with a thickness of 1.3 to 2.4mm, and the outer core layer has a Shore D hardness of 20-70 with a thickness of 1.3 to 2.5mm (Figure 2). The product of the Shore D hardness of the outer core layer and cover layer would be 1000 to 4200

which is implied within Figure 2. Yamagishi et al. (USPN 5695413) fails to disclose dimples. Kasashima et al. discloses a golf ball having three types of dimples having different sizes wherein the total  $V_r$  is greater than 0.6% but less than 1.5% and the number of dimples are 250 to 600 (See Detailed Description of the Invention paragraphs 0017 and 0018). The  $V_r$  and dimples both improve the flight distance of the golf ball (Detailed Description of the Invention paragraph 0001). One having ordinary skill in the art would have found it obvious to incorporate the dimples and  $V_r$ , taught by Kasashima et al., into the golf ball of Yamagishi et al. in order to improve the flight distance of the golf ball.

### ***Response to Arguments***

Applicant's arguments with respect to claims 2-5 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin A. Hunter whose telephone number is 703-306-5693. The examiner can normally be reached on Monday through Friday from 7:30AM to 4:00PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Garbe, can be reached on 703-308-1207. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

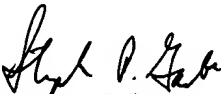
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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Alvin A. Hunter, Jr.

  
Stephen P. Garbe  
Primary Examiner